IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Fellenstein et al.**	§	Group Art Unit: **2143**
	§	
Serial No. **10/617,527**	§	Examiner: **Jean Gilles, Jude**
	§	
Filed: **July 10, 2003**	§	Customer No.: **50170**
	§	
For: **E-Mail Route Trace Functionality**	§	
	§	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPELLANTS' BRIEF (37 C.F.R. § 41.37)

This Appeal Brief is in furtherance of the Notice of Appeal filed October 12, 2007 (37 C.F.R. § 41.31).

The fees required under § 41.20(b)(2), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying Fee Transmittal.

I. Real Party in Interest

The real party in interest in this appeal is the following party: International Business Machines Corporation.

II. Related Appeals and Interferences

With respect to other appeals and interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

III. Status of Claims

The status of the claims involved in this proceeding is as follows:

1. Claims canceled: NONE
2. Claims withdrawing from consideration but not canceled: NONE
3. Claims pending: 1-33
4. Claims allowed: NONE
5. Claims rejected: 1-33

The claims on appeal are: claims 1-33.

IV. Status of Amendments

No amendments to the application were filed subsequent to mailing of the Final Office Action.

V. Summary of Claimed Subject Matter

With regard to independent claim 1, a method for providing electronic mail (e-mail) services (e.g., page 4, lines 24-25). The method may comprise receiving from an original sender a request for tracing notifications, for an e-mail message (e.g., page 4, line 28, to page 5, line 3 and page 6, lines 27-29). The method may further comprise creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications in response to said request (e.g., page 6, line 29, to page 7, line 2). The method may further comprise receiving at a computing device of the original sender said tracing notifications from one or more non-original recipients (e.g., page 7, lines 4-6) in response to said e-mail message being forwarded by an original recipient to at least one non-original recipient (e.g., page 7, lines 3-4).

With regard to independent claim 7, a method for providing e-mail services (e.g., page 4, lines 24-25). The method may comprise transmitting tracing notifications to a computing device of said original sender from one or more non-original recipients (e.g., page 7, lines 4-6) in response to an e-mail message being forwarded by an original recipient to at least one non-original recipient (e.g., page 7, lines 3-4) in response to a request from an original sender (e.g., page 4, line 28, to page 5, line 3 and page 6, lines 27-29).

With regard to independent claim 16, a system for providing e-mail services (e.g., page 4, lines 24-25). The system may comprise means for receiving from an original sender a request for tracing notifications (e.g., 204 or 205 in Figure 2), for an e-mail message (e.g., page 4, line 28, to page 5, line 3 and page 6, lines 27-29, 230 in Figure 2). The system may further comprise means responsive to said request, for creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications (e.g., page 6, line 29, to page 7, line 2, 230 in Figure 2). The system may further comprise means responsive to said tag, for transmitting said tracing notifications to a computing device of said original sender from one or more non-original recipients (e.g., page 7, lines 4-6, 250 or 260 in Figure 2) in response to said e-mail message being forwarded by an original recipient to at least one non-original recipient (e.g., page 4, line 28, to page 5, line 3 and page 6, lines 27-29, 230 in Figure 2).

With regard to independent claim 25, a computer-usable medium having computer-executable instructions for providing e-mail services (e.g., page 4, lines 24-25 and page 16, lines

7-19). The computer-usable medium may comprise means for receiving from an original sender a request for tracing notifications (e.g., 204 or 205 in Figure 2), for an e-mail message (e.g., page 4, line 28, to page 5, line 3 and page 6, lines 27-29, 230 in Figure 2). The computer-usable medium may further comprise means responsive to said request, for creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications (e.g., page 6, line 29, to page 7, line 2, 230 in Figure 2). The computer-usable medium may further comprise means responsive to said tag, for transmitting said tracing notifications to a computing device of said original sender from one or more non-original recipients (e.g., page 7, lines 4-6, 250 or 260 in Figure 2) in response to said e-mail message being forwarded by an original recipient to at least one non-original recipient (e.g., page 4, line 28, to page 5, line 3 and page 6, lines 27-29, 230 in Figure 2).

VI. Grounds of Rejection to be Reviewed on Appeal

The only ground of rejection to be reviewed on appeal is the rejection of claims 1-33 under 35 U.S.C. § 102(a) as being allegedly unpatentable over Lessa et al. (U.S. Publication No. 2002/0040387 A1) in view of Klug (U.S. Patent No. 7,085,745 B2).

VII. Argument

A1. Independent claims 1, 7, 16, and 25

Claim 1 reads as follows:

1. A method for providing electronic mail (e-mail) services, said method comprising:

receiving from an original sender a request for tracing notifications, for an e-mail message;

in response to said request, creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications; and

receiving at a computing device of the original sender said tracing notifications from one or more non-original recipients in response to said e-mail message being forwarded by an original recipient to at least one non-original recipient. (emphasis added)

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Appellants respectfully submit that Lessa and Klug, taken alone or in combination, fail to teach or suggest receiving at a computing device of the original sender the tracing notifications from one or more non-original recipients in response to the e-mail message being forwarded by an original recipient to at least one non-original recipient. Since the references fail to teach or suggest tracing notifications being received at a computing device of the original sender from one or more non-original recipients in response to the e-mail message being forwarded by an original recipient to at least one non-original recipient, the Examiner has failed to establish a *prima facie* case of obviousness, because the Examiner does not show where each and every claim limitation is taught or fairly suggested by the applied prior art.

Lessa is directed to tracing an electronic mail message to determine when the recipient has opened the message. Lessa describes a server that intercepts e-mail messages intended for the recipient, modifies the e-mail to add HTML code to the message, and forwards the message to the recipient. When the recipient opens the email, the HTML code in the email causes the recipient's mail client program to request a file from the server. When the server detects the request, the server knows that the mail message has been opened and thereafter informs the sender.

The Examiner seems to acknowledge that Lessa does not teach or suggest the use of tracing notifications that operate when the e-mail message is forwarded to at least one non-original recipient. However, the Examiner alleges that Klug discloses such a feature. Appellants respectfully disagree.

Klug is directed to sorting, prioritizing, identifying, managing, and otherwise controlling a communication, such as an email. Klug uses a frank to associate a value and a class with a communication. The communication may be associated with the frank through the method of selecting a frank associated with a value from among a plurality of frank types, each of the frank types having a pre-assigned value, associating the frank with the communication, and initiating transmission of the franked communication across a network. Klug describes that the "franking" of a communication generally associates some indicia of value and/or a service class with a communication.

The Examiner alleges that Klug teaches tracing notifications that operate when the e-mail message is forwarded to at least one non-original recipient in column 28, lines 58-67, and column 30, lines 33-47, which read as follows:

> In addition to the delivery receipt function described above, the certified mail features of the franking systems described herein may include a tracing function. That is, when a franked e-mail/communication 105 is certified for delivery, its path through the network 120 from the sending e-mail/communication server 210 to the receiving e-mail/communication server 225 may be logged. Typically, this log takes the form of a series of network addresses. The log may also indicate whether an e-mail/communication 105 was copied or stored at a network node. Optionally, the copying and storage elements of the log may be available only if an additional frank 110 is purchased.

(Klug, column 28, line 58, to column 29, line 2)

> As another example, a first class or higher category e-mail/communication 105 may be forwarded to a plurality of additional recipients and/or to the first recipient if the first attempt failed and "bounced." Such forwards may occur, for example, without payment of additional franks by a forwarding recipient or sender. Alternately, such forwards may occur to N additional recipients, wherein N may be defined by the original sender, the recipient or otherwise. As such, it is to be appreciated that any given frank 110 may be associated with particular rules and procedures including, but not limited to, forwarding rules. Such rules may be specified by servers 305, 900, 905, 910, franking service providers, senders, recipients, or others, or otherwise specified.

(Klug, column 30, lines 33-47)

In column 30, lines 33-47, Klug describes that a first class or higher category e-mail may be forwarded to a plurality of additional recipients and/or to the first recipient if the first attempt failed and "bounced." Appellants respectfully submit that merely resending or forwarding an email does not teach or suggest receiving at a computing device of the original sender the tracing notifications from one or more non-original recipients in response to the e-mail message being forwarded by an original recipient to at least one non-original recipient. That is, there is no tracing notification sent to the original sender if the original recipient forwards the email to another recipient.

In column 28, line 58, to column 29, line 2, Klug describes a tracing function that traces a path of an email through a network from the sending e-mail/communication server to the receiving e-mail/communication server, which may take the form of a log. Klug describes that the log may typically take the form of a series of network addresses and may also indicate

whether the e-mail was copied or stored at a network node. Thus, Klug describes tracing the path that an email takes at the request of the original sender through a network from the original sender to an original recipient or, independently, tracing the path that an email takes through a network if the original recipient forwards the email to at least one non-original recipient. Appellants respectfully submit that Klug does not teach or suggest that any tracing of the path that an email, sent by an **original recipient**, takes through a network to the at least one **non-original recipient** is ever sent to the **original sender**. That is, Klug merely teaches sending, to an **original sender**, the tracing of the path that an email takes to an original recipient. Klug does not teach or suggest a feature where the tracing notifications are received at a computing device of the **original sender** from one or more **non-original recipients** in response to the e-mail message being forwarded by an **original recipient** to at least one **non-original recipient**.

Furthermore, no suggestion is present in any of the references to modify the references to include such a feature. That is, there is no teaching or suggestion in Lessa and Klug, taken alone or in combination, that a problem exists for which receiving at a computing device of the original sender the tracing notifications from one or more non-original recipients in response to the e-mail message being forwarded by an original recipient to at least one non-original recipient, is a solution. To the contrary, Lessa merely notifies a sender that an original recipient has opened an email when HTML code in the email causes the recipient's mail client program to request a file from the server and Klug merely traces the path an email takes through a network from a sender to a recipient and allows for forwarding of emails.

Moreover, neither reference teaches or suggests the desirability of incorporating the subject matter of the other reference. That is, there is no motivation offered in either reference for the alleged combination. The Examiner alleges that the motivation would be "for the purpose of improving the ability of a network." The present invention provides for receiving at a computing device of the original sender the tracing notifications from one or more non-original recipients in response to the e-mail message being forwarded by an original recipient to at least one non-original recipient. As discussed above, Lessa merely notifies a sender that an original recipient has opened an email when HTML code in the email causes the recipient's mail client program to request a file from the server and Klug merely traces the path an email takes through a network from a sender to a recipient and allows for forwarding of emails. Neither reference

teaches or suggests tracing notifications that are received at a computing device of the **original sender** from one or more **non-original recipients** in response to the e-mail message being forwarded by an **original recipient** to at least one **non-original recipient**. Thus, the only teaching or suggestion to even attempt the alleged combination is based on a prior knowledge of Appellants' claimed invention thereby constituting impermissible hindsight reconstruction using Appellants' own disclosure as a guide.

One of ordinary skill in the art, being presented only with Lessa and Klug, and without having a prior knowledge of Appellants' claimed invention, would not have found it obvious to combine and modify Lessa and Klug to arrive at Appellants' claimed invention, as recited in claim 1. To the contrary, even if one were somehow motivated to combine Lessa and Klug, and it were somehow possible to combine the systems, the result would not be the invention, as recited in claim 1. The resulting system would merely notify a sender that an original recipient has opened an email, provide a trace of the path that the email took through the network, and allow the email to be forwarded. The resulting system would still fail to provide trace notifications that operate when the e-mail message is forwarded by an original recipient to at least one non-original recipient.

Similar distinctions over Lessa and Klug, whether taken alone or in combination, apply to independent claims 7, 16, and 25. That is, independent claims 7, 16, and 25 recite "**transmitting tracing notifications to a computing device of said original sender from one or more non-original recipients in response to an e-mail message being forwarded by an original recipient to at least one non-original recipient**." (emphasis added) As discussed above, Lessa and Klug, taken alone or in combination, fail to teach or suggest receiving at a computing device of the original sender the tracing notifications from one or more non-original recipients in response to the e-mail message being forwarded by an original recipient to at least one non-original recipient. Thus, Lessa and Klug, taken alone or in combination, for similar reasons set forth above with regard to claim 1, also does not teach or suggest the features of independent claims 7, 17, and 25.

In view of the above, Appellants respectfully submit that Lessa and Klug, taken alone or in combination, fail to teach or suggest the features of claims 1, 7, 16, and 25. At least by virtue of their dependency on claims 1, 7, 16, and 25, the features of dependent claims 2-6, 8-15, 17-24,

and 26-33 are not taught or suggested by Lessa and Klug, whether taken individually or in combination. Accordingly, Appellants respectfully request withdrawal of the rejection of claims 1-33 under 35 U.S.C. § 103(a).

A2. Examiner's Response and Rebuttal

In response to the above arguments, the Examiner, in the Final Office Action alleges:

Applicant's Request for Reconsideration filed on 05/22/2007 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention:

A: *the email to at least one non-original recipient. Applicants respectfully submit that Klug does not teach or suggest that any tracing of the path that an email, sent by an original recipient, takes through a network to the at least one non-original recipient is ever sent to the original sender. That is, Klug merely teaches sending, to an original sender, the tracing of the path that an email takes to an original recipient. Klug does not teach or suggest a feature where the tracing notifications are received at a computing device of the original sender from one or more non-original recipients in response to the e-mail message being forwarded by an original recipient to at least one non-original recipient.*

B: *Moreover, neither reference teaches or suggests the desirability of incorporating the subject matter of the other reference. That is, there is no motivation offered in either reference for the alleged combination.*

C: *Independent claims 7, 16, and 25 recite similar subject matter to that in independent claim* **7.** *That is independent claims 7, 16, and 25 recite "transmitting tracing notifications* ***to a computing device of*** *said original sender from one or more non-original recipients in response to an e-mail message being forwarded by an original recipient to at least one non-original recipient." (emphasis added).*

As to point A, it is the position of the Examiner that forwarding and email form one original recipient to other recipient as indicated in the rejection of claim 1 below [see Klug; column 28; lines 58-67; column 30, lines 33-47]. In addition, klug discloses tracing the routing of such emails , thus permitting the original sender to know information such as which servers or possible sites that emails have been forward to or from. Furthermore, techniques to retrace the network path of the email/communication is also provided. [see Klug; *see Klug, column 8, lines 58-67, continue in lines* 3-2 *2 in column* 29].

As to point B, see rejection of claim 1 below for reason to combine and motivation.
Point C as stated by the applicants states the same subject matter as claim 1. see point A above

The Examiner indicates in his response that Klug forwards an email from one original recipient to another recipient and traces the routing of such an email. Appellants have included a diagram, Exhibit A, illustrating the operation of the Klug system in the Evidence Appendix of this Appeal Brief. In the diagram of the Klug system it is shown that Klug will trace the path of the email from the sender to the original recipient and report the tracing of that path back to the sender. If the email is forwarded by the original recipient to a non-original recipient, only the original recipient would be informed of the path that the forwarded email took to the non-original recipient. In the Klug system, the sender would not be informed of the path that the forwarded email took. In other words Klug merely traces from a sender to the sender's designated recipient. There is no ability for a sender to know what the sender's recipient does with the email after it is received by the recipient, e.g., who the recipient forwards the email to.

In contradistinction, as is shown in the diagram of Exhibit B in the Evidence Appendix of this Appeal Brief, with the presently claimed invention, while the sender is notified of the trace of the path of the email from the sender to the original recipient, the sender is also notified of the trace of the path of an email forwarded by the original recipient to a non-original recipient. Thus, Appellants respectfully submit that Klug merely teaches to trace the path of the email from the sender to the original recipient. The sender in Klug has no information about where the email is forwarded, where the presently claimed invention fully informs the sender of where a recipient has forwarded the sender's email. There simply is no teaching or suggestion of receiving at a computing device of the original sender said tracing notifications from one or more non-original recipients in response to said e-mail message being forwarded by an original recipient to at least one non-original recipient.

B1. <u>Dependent claims 2, 8-11, 17-20, and 26-29</u>

With regard to claim 2 and similar subject matter recited in claims 8-11, 17-20, and 26-29, Lessa and Klug, taken alone or in combination, fail to teach or suggest one or more limiting

actions selected from a group consisting of: limiting the time during which the tracing notifications operate, limiting the number of retransmissions for which the tracing notifications operate, limiting the tracing notifications' operation, based on a domain policy, limiting the content of the tracing notifications, and discontinuing the tracing notifications, in response to a signal from the original sender. The Examiner alleges that this feature is taught by Lessa in paragraph [0022], which reads as follows:

> [0022] Once recipient 30 opens e-mail message 41, the <IMG> HTML tag is executed, and the mail reader attempts to execute a CGI-SCRIPT which was named using the UIC associated with original e-mail message 40. The UIC was passed as the SRC attribute in the <IMG> tag, which was added to e-mail message 42 by gateway server 20. The recipient's mail reader then makes a request 42 to gateway server 20 to execute the CGI-SCRIPT. Gateway system 20 detects request 42 and retrieves the address of sender 10 of original e-mail message 40, which is also associated with the UIC. Using this address, gateway system 20 sends an e-mail message 43 back to sender 10 notifying him that original message 40 has been opened by recipient 30. Notification e-mail message 43 can contain, among other things, the date and time that e-mail message 41 was opened by recipient 30 and the number of times that recipient 30 has opened the e-mail. In another embodiment of the invention, sender 10 may be able to indicate that no notification e-mails are to be sent back to sender 10. Instead, the sender 10 may access gateway server 20 via a web interface to check the status of messages that he has sent via gateway server 20.

(Lessa, paragraph [0022])

In this paragraph, Lessa describes that an email sent to a recipient by a sender is first stopped by a gateway system where an <IMG> HTML tag is inserted in the email so that, when the email is opened by the recipient, the <IMG> HTML tag is activated and the gateway system executes a CGI-SCRIPT to notify the sender that the email has been opened by the original recipient. Nowhere in this section, or any other section of Lessa, is there a teaching or suggestion of limiting the time during which the tracing notifications operate. Thus, Lessa merely describes a read receipt system that works with all email systems. The Examiner alleges that knowing the date and time to open and access an email message implies the function of controlling the timing of viewing such an email notification. Appellants respectfully submit that Lessa's read receipt system is not limited by the amount of time during which the tracing notifications operate. That is, Lessa describes a system which has an embedded HTML tag that is permanently attached to the email and only operates when the email is opened. In contradistinction, the present

application limits the time during which tracing notifications operate such that, after some predetermined time period, an e-mail message that is forwarded by an original recipient to at least one non-original recipient will not notify the original sender of the forwarding of the email. Nowhere does Lessa or Klug, taken alone or in combination, teach such a feature.

Additionally, the Examiner alleges that the cited section of Lessa teaches limiting the number of retransmissions for which the tracing notifications operate. The Examiner merely cites the section without providing any interpretation of how the section allegedly teaches or suggests this feature. Appellants respectfully submit that nowhere in this section, or any other section of Lessa or Klug, it there a teaching or suggestion of limiting the number of times an original recipient can retransmit an email to at least one non-original recipient where the tracing notifications requested by the original sender operate. Further, the Examiner alleges that the cited section of Lessa teaches limiting the operation of the tracing operation based on a domain policy. Again, the Examiner merely cites the section without providing any interpretation of how the section allegedly teaches or suggests this feature. Appellants respectfully submit that nowhere in this section, or any other section of Lessa or Klug, it there a teaching or suggestion of limiting the number of times an original recipient can retransmit to at least one non-original recipient where the tracing notifications requested by the original sender operate. That is, Lessa describes a read receipt system that works with all email systems. Thus, Lessa actually teaches away from limiting the operation of the tracing operation based on a domain policy.

Still further, the Examiner alleges that Lessa teaches limiting the content of the tracing notifications. Again, the Examiner merely cites the section without providing any interpretation of how the section allegedly teaches or suggests this feature. Appellants respectfully submit that nowhere in this section, or any other section of Lessa or Klug, is there a teaching or suggestion limiting the content of the tracing notifications. That is, nowhere in any section of Lessa or Klug is there a teaching or suggestion of analyzing the contents of the email to determine if based on the contents an original sender will be notified using tracing notification when an e-mail message is forwarded by an original recipient to at least one non-original recipient.

Even further, the Examiner alleges that Lessa teaches discontinuing the tracing notifications, in response to a signal from the original sender. The Examiner alleges that the address of the gateway is used to send a message back to the original sender. Appellants respectfully submit that the read receipt system of Lessa, either alone or in combination with

Klug, does not teach or suggest discontinuing the tracing notifications where an original sender is notified when an e-mail message that is forwarded by an original recipient to at least one non-original recipient is discontinued based on a signal from the original sender.

Thus, Lessa and Klug, taken alone or in combination fail to teach or suggest one or more limiting actions selected from a group consisting of: limiting the time during which the tracing notifications operate, limiting the number of retransmissions for which the tracing notifications operate, limiting the tracing notifications' operation, based on a domain policy, limiting the content of the tracing notifications, and discontinuing the tracing notifications, in response to a signal from the original sender, as recited in claim 2 and similar subject matter recited in claims 8-11, 17-20, and 26-29.

Thus, in addition to being dependent upon their respective independent claims, dependent claims 2, 8-11, 17-20, and 26-29 may be distinguished over Lessa and Klug, either alone or in combination, based on the specific features recited in these claims.

B2. Examiner's Response and Rebuttal

In the Final Office Action, the Examiner did not provide any response to the above arguments. Therefore, it is believed that Appellants' arguments are compelling and the Board should overturn the rejection of claims 2, 8-11, 17-20, and 26-29, as the Examiner does not even have sufficient confidence in his rejection to form a rebuttal of Appellants' arguments.

C1. Dependent claim 5

With regard to claim 5, Lessa and Klug, taken alone or in combination, fail to teach or suggest transmitting the tracing notifications to the original sender from the at least one non-original recipient. The Examiner alleges that this feature is taught by Lessa at paragraph [0022] and by Klug at column 30, lines 33-47, both reproduced above. As discussed above, in paragraph [0022] Lessa describes an email that is sent to a recipient by a sender and is first stopped by a gateway system where an <IMG> HTML tag is inserted in the email so that, when the email is opened by the recipient, the <IMG> HTML tag is activated and the gateway system executes a CGI-SCRIPT to notify the sender that the email has been opened by the original

recipient. In column 30, lines 33-47, Klug describes that a first class or higher category e-mail may be forwarded to a plurality of additional recipients and/or to the first recipient if the first attempt failed and "bounced." While Lessa may teach a system where a sender is notified that an original recipient has opened an email, the combination of Lessa with Klug merely teaches a system where the original recipient of the email can forward the email to a non-original recipient and the original recipient will be notified that the non-original recipient has opened the forwarded email. Thus, Appellants respectfully submit that Lessa and Klug, taken alone or in combination, fail to teach or suggest a system that notifies the original sender that a non-original recipient has opened an email using a tracing notification.

Thus, in addition to being dependent upon independent claim 1, dependent claim 5 may be distinguished over Lessa and Klug, either alone or in combination, based on the specific features recited in these claims.

C2. Examiner's Response and Rebuttal

In the Final Office Action, the Examiner did not provide any response to the above arguments. Therefore, it is believed that Appellants' arguments are compelling and the Board should overturn the rejection of claim 5, as the Examiner does not even have sufficient confidence in his rejection to form a rebuttal of Appellants' arguments.

D1. Dependent claim 6, 12, 13, 21, 22, 30, and 21

With regard to claim 6 and similar subject matter in claims 12, 13, 21, 22, 30, and 31, Lessa and Klug, taken alone or in combination, fail to teach or suggest transmitting one or more tracing notifications selected from a group consisting of: notifications reporting that the message has been sent somewhere in some manner, notifications reporting that the content of the message was provided to the at least one non-original recipient, and notifications reporting deletion of the message. The Examiner alleges that Lessa teaches notifications reporting that the message has been sent somewhere in some manner at paragraph [0003], which reads as follows:

> [0003] The concept of the sender of a message receiving notification when the message has been received by the recipient is well known in the prior art. In the

> non-electronic world it is possible to send mail "certified" or "return receipt requested" to receive confirmation that the message has reached its destination. Likewise, in the domain of electronic mail, users in a homogeneous environment, such as on an intranet where all users are using the same email program, are able to track the read/unread status of sent e-mails or to receive notification via a return e-mail message when the recipient has read the message.

(Lessa, paragraph [0003])

In this section, Lessa describes a system where a sender is notified that an original recipient has opened an email. In contradistinction, the present application notifies an original sender that one of the original recipients has sent the email in a manner, such as forwarding the email to a non-original recipient. As discussed above, Lessa and Klug, taken alone or in combination, fail to teach such a feature.

Additionally, the Examiner alleges that Klug teaches notifications reporting that the content of the message was provided to the at least one non-original recipient at column 30, lines 30-47, reproduced above. As discussed above, this section of Klug describes that a first class or higher category e-mail may be forwarded to a plurality of additional recipients and/or to the first recipient if the first attempt failed and "bounced." Appellants respectfully submit that merely forwarding or resending an email does not teach or suggest sending a notification to an original sender that reports that the content of the message was provided to the at least one non-original recipient by the original recipient.

Further, the Examiner alleges that Klug teaches notifications reporting deletion of the message at column 9, lines 39-52, which reads as follows:

> In yet another embodiment, one or more "franking servers" may be utilized to provide franks 110, prioritize e-mails/communications 105 into separate service classes, and/or to categorize communications. Such categorization of e-mails/communications 105 may occur on behalf of individual recipients, groups of recipients, and so on. In this embodiment, the franking server may instruct the recipient's system 125 to properly classify and present franked e-mails. The franking server may also be configured to delete unfranked e-mails/communications 105, delay transmitting unfranked e-mails/communications (for example until all franked e-mails/communications have been transmitted and/or received), and/or to perform other operations as requested by recipients or others, such as server operators.

(Klug, column 9, lines 39-52)

In this section, Klug merely describes deleting unfranked emails at the request of a recipient. Nowhere, in this section or any other section of Klug, is there a notification sent to the original sender when the email is deleted. That is, all Klug describes is the deletion of the email. Appellants respectfully submit that simply deleting an email does not teach or suggest reporting the deletion of the email by an original recipient to an original sender. Thus, Lessa and Klug, taken alone or in combination fail to teach or suggest transmitting one or more tracing notifications selected from a group consisting of: notifications reporting that the message has been sent somewhere in some manner, notifications reporting that the content of the message was provided to the at least one non-original recipient, and notifications reporting deletion of the message, as recited in claim 6 and similar subject matter recited in claims 12, 13, 21, 22, 30, and 31.

Thus, in addition to being dependent upon their respective independent claims, dependent claims 6, 12, 13, 21, 22, 30, and 31 may be distinguished over Lessa and Klug, either alone or in combination, based on the specific features recited in these claims.

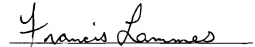
D2. Examiner's Response and Rebuttal

In the Final Office Action, the Examiner did not provide any response to the above arguments. Therefore, it is believed that Appellants' arguments are compelling and the Board should overturn the rejection of claims 6, 12, 13, 21, 22, 30, and 31, as the Examiner does not even have sufficient confidence in his rejection to form a rebuttal of Appellants' arguments.

VIII. Conclusion

In view of the above, Appellants respectfully submit that claims 1-33 of the present application are directed to statutory subject matter and that the features of these claims are not taught or suggested by the Lessa and Klug references. Accordingly, Appellants request that the Board of Patent Appeals and Interferences overturn the rejections set forth in the Final Office Action.

Respectfully submitted,



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AGENT FOR APPELLANTS

CLAIMS APPENDIX

1. A method for providing electronic mail (e-mail) services, said method comprising:

receiving from an original sender a request for tracing notifications, for an e-mail message;

in response to said request, creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications; and

receiving at a computing device of the original sender said tracing notifications from one or more non-original recipients in response to said e-mail message being forwarded by an original recipient to at least one non-original recipient.

2. The method of Claim 1, further comprising:

providing limits for said tracing notifications, wherein said providing limits further comprises one or more limiting actions selected from a group consisting of:

limiting the time during which said tracing notifications operate,

limiting the number of retransmissions for which said tracing notifications operate,

limiting said tracing notifications' operation, based on a domain policy,

limiting the content of said tracing notifications,

and discontinuing said tracing notifications, in response to a signal from said original sender.

3. The method of Claim 1, further comprising:

providing to a user

a representation of said e-mail message,

together with information as to who has been provided with the content of said e-mail message.

4. The method of Claim 3, further comprising:

storing and updating said information.

5. The method of Claim 1, further comprising:

transmitting said tracing notifications to said original sender, from said at least one non-original recipient.

6. The method of Claim 5, wherein said transmitting tracing notifications further comprises transmitting one or more tracing notifications selected from a group consisting of:

notifications reporting that said message has been sent somewhere in some manner,

notifications reporting that the content of said message was provided to said at least one non-original recipient,

and notifications reporting deletion of said message.

7. A method for providing e-mail services, said method comprising:

in response to a request from an original sender, transmitting tracing notifications to a computing device of said original sender from one or more non-original recipients in response to an e-mail message being forwarded by an original recipient to at least one non-original recipient.

8. The method of Claim 7, further comprising:

providing limits for said tracing notifications, wherein said providing limits further comprises:

limiting the time during which said tracing notifications operate.

9. The method of Claim 7, further comprising:

providing limits for said tracing notifications, wherein said providing limits further comprises:

limiting the number of retransmissions for which said tracing notifications operate.

10. The method of Claim 7, further comprising:

providing limits for said tracing notifications, wherein said providing limits further comprises:

responsive to a signal from said original sender, discontinuing said tracing notifications.

11. The method of Claim 7, further comprising:

providing limits for said tracing notifications, wherein said providing limits further comprises:

limiting said transmitting, based on a domain policy.

12. The method of Claim 7, wherein said transmitting tracing notifications further comprises:

signaling that the content of said e-mail message has been provided to said at least one non-original recipient.

13. The method of Claim 7, wherein said transmitting tracing notifications further comprises:

signaling that said e-mail message has been forwarded to said at least one non-original recipient.

14. The method of Claim 7, further comprising:

providing to a user

a representation of said e-mail message,

together with information as to who has been provided with the content of said e-mail message.

15. The method of Claim 14, further comprising:

storing and updating said information.

16. A system for providing e-mail services, said system comprising:

means for receiving from an original sender a request for tracing notifications, for an e-mail message;

means responsive to said request, for creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications; and

means responsive to said tag, for transmitting said tracing notifications to a computing device of said original sender from one or more non-original recipients in response to said e-mail message being forwarded by an original recipient to at least one non-original recipient.

17. The system of Claim 16, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting the time during which said tracing notifications operate.

18. The system of Claim 16, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting the number of retransmissions for which said tracing notifications operate.

19. The system of Claim 16, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means responsive to a signal from said original sender, for discontinuing said tracing notifications.

20. The system of Claim 16, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting said transmitting, based on a domain policy.

21. The system of Claim 16, wherein said means for transmitting tracing notifications further comprises:

means for signaling that the content of said e-mail message has been provided to at least one non-original recipient.

22. The system of Claim 16, wherein said means for transmitting tracing notifications further comprises:

means for signaling that said e-mail message has been forwarded to said at least one non-original recipient.

23. The system of Claim 16, further comprising:

means for providing to a user

a representation of said e-mail message,

together with information as to who has been provided with the content of said e-mail message.

24. The system of Claim 23, further comprising:

means for storing and updating said information.

25. A computer-usable medium having computer-executable instructions for providing e-mail services, said computer-usable medium comprising:

means for receiving from an original sender a request for tracing notifications, for an e-mail message;

means responsive to said request, for creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications; and

means responsive to said tag, for transmitting said tracing notifications to a computing device of said original sender from one or more non-original recipients in response to said e-mail message being forwarded by an original recipient to at least one non-original recipient.

26. The computer-usable medium of Claim 25, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting the time during which said tracing notifications operate.

27. The computer-usable medium of Claim 25, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting the number of retransmissions for which said tracing notifications operate.

28. The computer-usable medium of Claim 25, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means responsive to a signal from said original sender, for discontinuing said tracing notifications.

29. The computer-usable medium of Claim 25, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting said transmitting, based on a domain policy.

30. The computer-usable medium of Claim 25, wherein said means for transmitting tracing notifications further comprises:

means for signaling that the content of said e-mail message has been provided to at least one non-original recipient.

31. The computer-usable medium of Claim 25, wherein said means for transmitting tracing notifications further comprises:

means for signaling that said e-mail message has been forwarded to said at least one non-original recipient.

32. The computer-usable medium of Claim 25, further comprising:

means for providing to a user

a representation of said e-mail message,

together with information as to who has been provided with the content of said e-mail message.

33. The computer-usable medium of Claim 32, further comprising:

means for storing and updating said information.

EVIDENCE APPENDIX

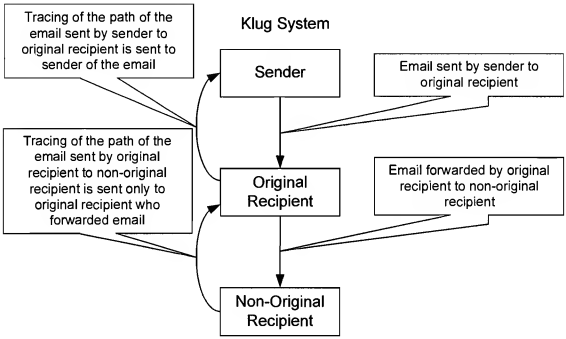

Exhibit A

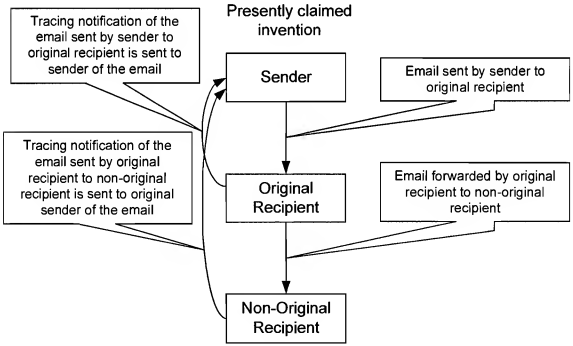

Exhibit B

RELATED PROCEEDINGS APPENDIX

NONE